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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,811	11/19/2001	Shawn Buchanan Greene	16911-8484	7339

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EXAMINER

CUFF, MICHAEL A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/992,811

Applicant(s)

GREENE, SHAWN BUCHANAN

Examiner

Michael Cuff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 32-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

## **DETAILED ACTION**

### ***Restriction***

1. Applicant has confirmed that claims 19-31 have been withdrawn from further consideration.

### ***Discussion on 35 USC 101 rejection***

2. Applicant asserts that the citing of *In re Toma* as a basis for determining the rejection is improper. Applicant asserts that the claims meet the 35 USC 101 requirement as shown in *State Street*. This legal decision is a matter of office policy, not examiner determination. See *Ex parte Bowman*, 61 USPQ2d 1665, 1671. While the *Bowman* case does not set precedent, the case analysis on what constitutes "technological art" was used as a basis for this policy. The rejection under 35 U.S.C. 101 for claims 1-18 and 32-37 and 39-40 is maintained.

### ***Declaration under 37 CFR 1.131***

3. Applicant has submitted a declaration asserting that applicant had the conception of the invention prior to the effective filing date of the Stonedahl reference. To support this declaration, applicant has provided four pieces of evidence. The examiner has read the evidence and has made the following conclusions.

There is a memorandum, which recites "The thought came to me as I was sleeping on the night of \_\_\_\_ I had seen Sting in Peoria, Illinois, which triggered this idea." According to the Internet, Sting played on May 16, 2001 in Peoria. There is evidence that the disclosure in this memorandum was conceived sometime after May

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16, 2001, but because of applicant's assertion, before June 20, 2001. (As a side note, page 2 of the declaration says that the conception of the invention occurred the night of that concert event. However, the memo does not say that because of some deletion. The memo now merely states that the thought came to him while he was sleeping and that the concert triggered the idea. The time connection is missing.)

Chronologically, the request for a search, dated July 20, 2001, came next. It is important to note that the second key to the invention in this request is not included in the first memo discussed. This feature is the determining of the number of copies to make based on the pre-event attendee sales. There is no evidence that this feature was conceived prior to June 20, 2001.

There is an August 2, 2001 search response, which shows diligence.

There is an Exhibit "A", which was established sometime after August 2, 2001 as seen on page 4 because the patent feasibility search (see above) was already completed. The document shows diligence.

There is no evidence that other features of the current claims were conceived prior to June 20, 2001. Some examples of these "other" features are the providing, at a venue, an opportunity to purchase; the recording occurring on site at the venue; the distributing copies before attendees exit the venue, the providing opportunity to purchase copies during the event; and the using of a global computer network.

The current art rejections are maintained because all of the current claims recite features, which are not shown to be conceived prior to June 20, 2001.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 and 32-37 and 39-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-18, 32-37 and 39-40 show a series of steps, which are grounded in the abstract idea of, for example, providing, recording, determining and calculating. The broadly recited steps do not recite sufficient computer structures that are within "technological arts". Therefore, they do not satisfy the statutory requirements of 35 USC 101. See *In re Toma*, 197 USPQ 852 (CCPA 1978).

The changes to fix this issue are relatively minor. For example, Claim 1 could be re-written so that the fourth step read --calculating, by a computer, a desirable number ... --. Notice that claim 38 is fine because it recites a computer.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Stonedahl. (To be clear, the examiner is using the filing date of the provisional application of the published Stonedahl application as the effective 102(e) filing date, which is June 20, 2001.)

Stonedahl shows, figure 1, a system for capturing and distributing event recordings. Figure 1 shows a live event system 300 (conducting live event). There is a central recording module 105 (recording live event). The attendee of the live event 101 uses a small handheld selection device 102, supplied to them by the event management to make the selections during the event (pre-purchased at event POS; page 3, second column, bottom). The selection device may relay information to an order processing system 111. The order collection system uses the information to generate production orders (calculating number of copies) that are formatted for use by a production facility 113 (manufacturing; page 3, first column, middle). The custom CD or other media can be delivered (distributing) to the attendee in as little as a matter of hours (cut off time/date) after the event. The system contains "local event centers" (box office, POS) at or near the event venue and "remote event centers" which are accessible by network connections, a web site interface, data or voice phone line connections, or by a physical store front (capable of receiving mail) or automated sales kiosk (page 3, first column, top). Customers can initiate the purchase process before, during and after the live event.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stonedahl in view of Griner et al.

Stonedahl shows all of the limitations of the claims except for specifying having the manufacturing on site and distributing the recording before the attendees exit the venue.

Stonedahl shows, figure 1, a system for capturing and distributing event recordings. Figure 1 shows a live event system 300 (conducting live event). There is a central recording module 105 (recording live event). The attendee of the live event 101 uses a small handheld selection device 102, supplied to them by the event management to make the selections during the event (pre-purchased at event POS; page 3, second column, bottom). The selection device may relay information to an order processing system 111. The order collection system uses the information to generate production orders (calculating number of copies) that are formatted for use by a production facility 113 (manufacturing; page 3, first column, middle). The custom CD or other media can be delivered (distributing) to the attendee in as little as a matter of hours (cut off time/date) after the event. The system contains "local event centers" (box office, POS) at or near the event venue and "remote event centers" which are

accessible by network connections, a web site interface, data or voice phone line connections, or by a physical store front (capable of receiving mail) or automated sales kiosk (page 3, first column, top). Customers can initiate the purchase process before, during and after the live event.

Griner et al. teaches, figure 1, a system for creating recordings of live performances to be available shortly after the event has ended (recording module on site and recording available to attendees before exiting the venue) in order to provide immediate and quick service to the customer.

Based on the teaching of Griner et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Stonedahl system to incorporate the faster manufacturing system of Griner et al. in order to provide immediate and quick service to the customer.

### ***Response to Arguments***

There are no arguments pertaining to the art rejections. It is assumed that applicant acquiesces that the art rejections are proper.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action



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and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (703) 308-0610. The examiner can normally be reached on 8:00 to 5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*Michael Cuff 12/10/03*

Michael Cuff  
December 10, 2003